

REMARKS

Claims 2-6 and 9 have been canceled without prejudice or disclaimer. Claims 1 and 8 have been amended. New claims 10-14 have been added. Claims 1, 7-8, and 10-14 are pending.

Amendments

Claim 1 has been amended to require the inclusion of Component A, formerly one of the Markush elements recited in the claim. Further, claim 1 has been amended to clarify that Component A is a phosphorus compound that comprises A-1 and A-2. Claim 8 has been amended to clarify that it is a lubricating oil composition that is being claimed, which is supported by the antecedent found in claim 7.

The specification has been amended to correct obvious typographical errors ("nonyl phenoxyacetate" to "nonylphenoxy acetic acid", and "C-A-1" and "C-B-1" to "G-A-1" and "G-B-1" respectively).

No new matter has been added.

Rejections Under 35 USC § 102(b)

Claims 1-5 are rejected as allegedly being anticipated by Baba (US2004/0053794). The rejection is respectfully traversed.

Regarding claims 1, 2 and 5, although Baba discloses a lubricative composition for industrial machinery and equipment in gear oil, the composition comprising a base oil selected from mineral oils, fats and oils, synthetic oils and mixture of two or more of them,  $\beta$ -dithiophosphorylated propionic acid (Component (A-1), a phosphorus-containing carboxylic acid of the present invention), Baba does not disclose the presently claimed composition. Claim 1 has been amended to define component (A) as a phosphorus compound comprising (A-1), a phosphorus-containing carboxylic acid, and (A-2), a thiophosphoric ester. Baba does not teach or suggest component (A-2). Claims 2-4 have been cancelled. Therefore, the rejection has been overcome, and its withdrawal is respectfully requested.

Nor can Baba be a basis of an obviousness rejection for a claim requiring component (A-2), given the lack of any teaching or suggestion of (A-2) in Baba.

It is noted that new claim 13 also requires component (A-2), and thus also is not anticipated, or rendered obvious, by Baba. As to new claims 10-12 and 14, these claims require the inclusion of either component (C-1) or component (C-2), excluding the case when R3 is an alkyl group having 7-29 carbon atoms. Baba does not teach or suggest a composition comprising

either (C-1) or (C-2) as recited in claims 10-12 and 14. Baba also does not teach or suggest component D which is required in claims 13 and 14.

Claims 1-4 and 7-9 are rejected as allegedly being anticipated by Yokota (US2002/0035043A1). The rejection is respectfully traversed.

The composition of amended claim 1, as well as dependent claims 7 and 8, comprises an essential component (A), and such a composition is not taught or suggested by Yokota. Claims 2 to 4 and 9 have been cancelled. The rejection over Yokota is therefore overcome, and its withdrawal is respectfully requested.

Component (C) is required in new claim 10, and this component is not taught by Yokota. Therefore, claim 10 and dependent claims 11 and 12 should not be rejected over Yokota. New claims 13 and 14 require component (D), which also is not present in a lubricative composition according to Yokota.

Claims 1-4 and 6 are rejected as allegedly anticipated by Baba W000/11122. The rejection is respectfully traversed.

Baba WO00/11122 does not disclose the composition of amended claim 1, because Baba WO00/11122 does not disclose component (A-1), which is required in the amended claims. Thus, the rejection of claim 1 over Baba WO00/11122 is overcome, and its withdrawal is respectfully requested. Claim 1 also cannot be rejected for obviousness over Baba WO00/11122. Claims 2-4 and 6 have been cancelled.

Claims 1-4 are rejected as being allegedly anticipated by Havelly, US 2,961,408. The rejection is respectfully traversed.

Claim 1 includes component (A) as an essential component, and this component is not taught or suggested by Havelly. Thus, the rejection of claim 1 over Havelly is overcome, and its withdrawal is respectfully requested. Claim 1 also cannot be rejected for obviousness over Havelly. Claims 2-4 have been cancelled.

It is noted that new claim 13 requires component (A-2), and thus also is not anticipated by Havelly. New claims 10-12 and 14 require the inclusion of either component (C-1) or component (C-2), excluding the case when R3 is an alkyl group having 7-29 carbon atoms. Havelly does not teach or suggest component (C)

with this exclusion. Therefore, new claims 10-14 cannot be rejected over Havelly.

Rejections Under 35 USC § 103(a)

Claims 7-9 are rejected as allegedly obvious over Baba(US2004/0053794) in view of Yokota (US 2002/0035043A1). The rejection is respectfully traversed. The rejection is moot with respect to claim 9, which has been cancelled.

The Office Action admits that Baba does not disclose component (A-2), which is required by the instant claims. The Office Action further admits that Yokota also does not disclose component (A). Because the Baba and Yokota references, singly or combined, fail to teach every limitation of the instant claims, the rejection has been overcome. Withdrawal of the rejection is respectfully requested.

Claims 7-9 are rejected as allegedly obvious over Baba(WO00/11122) in view of Yokota (US 2002/0035043A1). The rejection is respectfully traversed.

Baba WO00/11122 does not disclose component (A-1), which is required in the instant claims. Yokota also does not disclose component (A). Therefore, Baba WO00/11122 and Yokota, taken

either singly or combined, fail to teach every limitation of the instant claims, and the rejection has been overcome. Withdrawal of the rejection is respectfully requested.

Claims 7-9 are rejected as allegedly obvious over Havelly (US 2,961,408) in view of Yokota (US 2002/0035043A1). The rejection is respectfully traversed.

The Office Action admits that Havelly does not disclose component (A), which is required by the claims. Yokota also does not disclose component (A). Therefore, Havelly and Yokota, taken either singly or combined, fail to teach every limitation of the instant claims, and the rejection has been overcome. Withdrawal of the rejection is respectfully requested.

Comment Regarding Further Art Made of Record

Fletschinger (2002/0016266A1) was made of record but not used in any rejection. Even if Fletschinger discloses a base oil for metal working fluid, gear oil and hydraulic fluid with polyol partial esters (D), dithiophosphoric acid esters, thiophosphoric acid ester (A-2), and a viscosity index improver, claims 1 and 13 of the present application recite "a phosphorus compound comprising a phosphorus-containing carboxylic acid and

a thiophosphoric ester", which is different from Fletschinger's disclosure. Fletschinger's dithiophosphoric acid esters do not correspond to component (A-1) of the present invention, since A-1 is not a phosphorus-containing carboxylic acid ester but a phosphorus-containing carboxylic acid.

Accordingly all of the rejections have been overcome, and therefore the withdrawal of the all the rejections is respectfully requested.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter which would expedite allowance of the present application.

Respectfully submitted,

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